

### REMARKS

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the opinion that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the following remarks and the attached Declaration of Mr. Yamazaki.

An Election/Restriction Requirement was put forward between Claims 1 and 6-8, drawn to the toner, Claim 2, drawn to the method of making the toner, and Claims 3-5, drawn to the method of using the toner. In a telephone Election, Applicants' below-signed representative, elected Group I, Claims 1 and 6-8 to the toner. Applicants hereby confirm this Election to Group I, Claims 1 and 6-8. Thus, the claims currently under prosecution are Claims 1 and 6-8.

One of the objects of the present Invention is to reduce the number of fine particles contained in the toner because fine particles have a deleterious effect on the quality of the print after repeated use. Such fine particles usually melt and adhere to the carrier and developer conveying member, see paragraph bridging pages 9 and 10 of the instant Application. Thus, Applicants specifically claim that particles having a size of 0.6 to 1.0  $\mu\text{m}$  is less than 5% in the claimed toner.

Ugai has been cited as anticipating Claims 1 and 6 and making obvious Claims 1 and 6-8. Hashimoto has been cited as anticipating, or making obvious, Claims 1 and 6-8. Applicants respectfully traverse these rejections. In both rejections, the Examiner has taken the position that each reference inherently teaches the amount of particles having a circle corresponding to the diameter of 0.6 to less than 1.0  $\mu\text{m}$  is less than 5% by number. Applicants disagree, based on the two references themselves, as well as tests which have been presented herein by way of Mr. Yamazaki's Declaration.

First, turning to the Patents themselves, it will be noted that both Patents test their materials using a Coulter Counter TA-II with either a 100  $\mu\text{m}$ -aperture or a 50  $\mu\text{m}$ -aperture. The 100  $\mu\text{m}$ -aperture is stated as determining the number of particles which fall within the range of 2 to 40  $\mu\text{m}$  while the 50  $\mu\text{m}$ -aperture is used to measure the number of particles falling within the range of 1 to 20  $\mu\text{m}$ , see Ugai, Column 17, line 66 through Column 18, line 3. See Hashimoto, Column 15, lines 20-25.

Thus, it is submitted that, on the face of both Ugai and Hashimoto, neither one of them test for particles which have a diameter within the range of 0.6 to less than 1.0  $\mu\text{m}$ . Since neither test for such material, it is submitted that one cannot calculate, from the data of either one of their references, the number of particles that would have a diameter less than 1.0  $\mu\text{m}$ .

It is on this basis that Applicants submit that the calculations and assumptions made by the Examiner in his inherency argument are not correct.

Applicants have gone one step further and tested the material of both Ugai and Hashimoto in order to determine how many particles fall within the range of 0.6 to 1.0  $\mu\text{m}$ . Based on the tests which are reported in Mr. Yamazaki's Declaration, it can be seen that the material of Ugai has 7.8% of its particles falling within this range while Hashimoto has 5.8% of its particles falling within this range. Thus, it is submitted that, based on the tests run by Mr. Yamazaki, neither Ugai nor Hashimoto inherently possess a toner which falls in the range of the recited claims because neither one of the references inherently teach particles which meet the limitations of the present Invention.

The Examiner should note that Mr. Yamazaki's Declaration is unexecuted. However, the data contained therein originated with Declarant and is, therefore, entirely reliable. The Declaration has been forwarded to Mr. Yamazaki for his signature and, as soon as the completed document is received, it will be filed in this case. In the meantime, the Examiner is respectfully requested to consider Mr. Yamazaki's Declaration in order to expedite the prosecution of this Application.

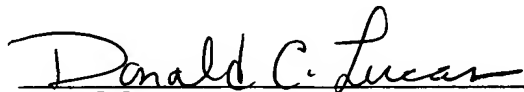
Respectfully, based on the arguments presented above and the data in Mr. Yamazaki's Declaration, it is respectfully submitted that the claims, as presented herein, are patentable over the two cited references taken alone or in combination.

In view of the foregoing and the enclosed, it is respectfully submitted that the Application is in condition for allowance and such action is respectfully requested. A three month extension of time within which to file a Response to the outstanding Office Action is hereby requested and PTO Form 2038 is enclosed herewith authorizing payment of the appropriate government extension fee. However, should any further fees or extensions of time be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit Account # 02-2275.

Respectfully submitted,

MUSERLIAN, LUCAS AND MERCANTI, LLP

By:



Donald C. Lucas  
(Attorney for Applicant(s))  
600 Third Avenue  
New York, New York 10016  
Tel. # (212) 661-8000

DCL/mr

Encl: Unexecuted Declaration of Mr. Hiroshi Yamazaki  
Executed PTO Form 2038 for \$930.00  
Return receipt post-card